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PATENT

OCT 16 2006

Docket No. 103864-139 US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

McErlean et al.

Serial No. 10/634,992

Filed: August 6, 2003

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Confirmation No.: 7424

Group Art Unit: 3721

Examiner: Hemant Desai

For: **AUTOMATED CONTAINER BULKING SYSTEM AND METHOD
OPTIONALLY INTEGRATED WITH AUTOMATED DISPENSING SYSTEM
AND/OR AUTOMATED LABELING AND PACKAGING SYSTEM**

Assistant Commissioner for Patents
Washington, D.C. 20231

DECLARATION UNDER 37 C.F.R. §1.131

We, James G. McErlean, Christian E. Hess, Chih-Jen Leu, and Mark A. Detri hereby
declare as follows:

1. We are the co-inventors of the above-referenced patent application, which
claims priority to U.S. application number 10/215,249 filed August 9, 2002, which claims
priority to U.S. provisional application 60/401,340, filed August 7, 2002.

2. All the work described within this declaration was performed in the United
States and/or Canada.

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Attorney Docket No. 10/634,991

3. All of the work described within this declaration was performed by us, or on our behalf and under our direction.

4. We have reviewed our records, including the exhibits submitted herewith, and readily conclude that an automated container bulking system and method optionally integrated with automated dispensing system and/or automated labeling and packaging system, as claimed within the subject application, including claims 1-92, was conceived and reduced to practice at least prior to December 04, 2001, i.e., the filing date of U.S. Patent 6,715,266 to Brown.

5. Attached is exhibit A, a Functional System Description document, entitled "Auto Drug Repacking System Bottle Range" dated at least by June 02, 1999, describing the claimed invention. This document was prepared for Merck-Medco, the assignee of the present invention based on our conception of the claimed invention and under our supervision. Portions of this document not relating to the claimed invention have been redacted to minimize the disclosure of unrelated confidential information.

6. Exhibit A clearly indicates that the invention comprising an automated system for emptying contents of pharmaceutical containers including medications; an automated system for emptying the contents of pharmaceutical containers; an automated system for emptying the contents of pharmaceutical containers, including medications; and an automated

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system for emptying contents of pharmaceutical containers including medications, as claimed within the subject application, including claims 1-92, was conceived at least as early as June 02, 1999 and Exhibit B indicates that the invention was reduced to practice at least as early as June 23, 2000. Attached is Exhibit B, an email disclosing the "client witness testing of the ultrasonic bottle splitter" at least as early as June 23, 2000 wherein the present invention based on our conception of the claimed invention and under our supervision was reduced to practice as a prototype.

7. In summary, upon review of our records, of which the above-cited pages are representative, we conclude that at least prior to December 04, 2001, i.e., the filing date of U.S. Patent 6,715,266 to Brown, we had conceived and reduced to practice the method and system, as described and claimed within the subject application in claims 1-92.

8. For example, we conclude that we reduced to practice prior to December 04, 2001, the subject matter of claim 1, reciting, in combination:

An automated system for emptying contents of pharmaceutical containers including medications, comprising:

a gripper unit for receiving and holding a pharmaceutical container;
a cutter for cutting the pharmaceutical container;
a rotating unit operable with said gripper unit that rotates at least a portion of said gripper unit to empty the contents of the pharmaceutical container.

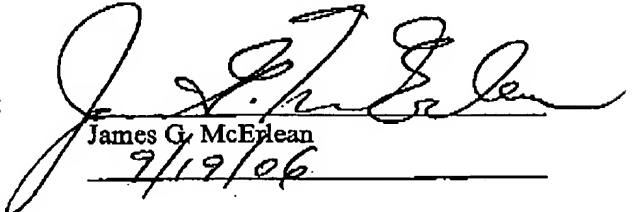
Serial No. 10/634,991
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9. In addition, we conclude that we reduced to practice prior to December 04, 2001, the subject matter of claims 2-92.

10. We further declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that the making of willfully false statements and the like is punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Signed:

Dated:


James G. McElean

9/19/06

Signed:

Dated:

Christian E. Hess

Signed:

Dated:

Chih-Jen Leu

Signed:

Dated:

Mark A. Detri

Exhibit A

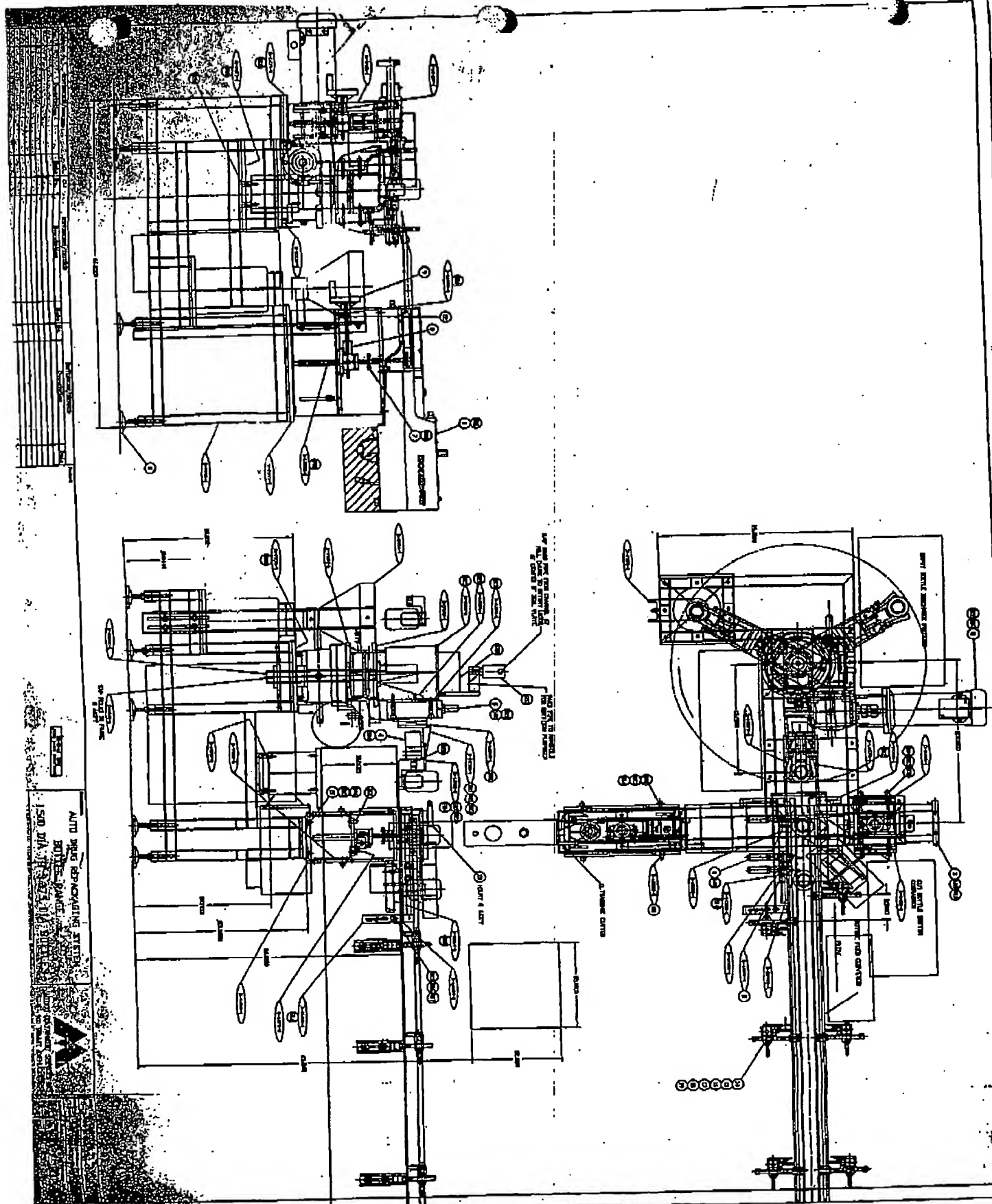


Exhibit B

-----Original Message-----

From: Mancuso, Carol
Sent: Monday, June 19, 2000 2:01 PM
To: Castillo, David; Hess, E. Chris; Liu, Alex; Swanger, Bill J.; Dennis, Patrick; Hunter, Roy
Cc: Chan, Rosellen
Subject: RE: reschedule of client witness testing
Importance: High

Based on everyone's response, the preferred date to meet with the vendor is Friday, June 23rd. The meeting time will be set up for 10:30am. Once again, please confirm your attendance with myself or Rosellen Chan.

Thank you,

Carol Mancuso

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From: Chan, Rosellen
Sent: Tuesday, June 13, 2000 3:01 PM
To: Castillo, David; Hess, E. Chris; Liu, Alex; Swanger, Bill J.; Dennis, Patrick
Cc: Mancuso, Carol; Hoffman, Marty
Subject: reschedule of client witness testing

The client witness testing of the Ultrasonic Bottle Slitter at Universal Equipment, Stowe, PA, scheduled for this Friday (6/16/00 AM) has been cancelled due to conflicting schedules of the attendees.

Please submit your availability to Ms. Carol Mancuso such that she may coordinate a date convenient to all parties. Let's aim for the week following.

Thanks,

Rosellen Chan

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4. We have reviewed our records, including the exhibits submitted herewith, and readily conclude that an automated container bulking system and method optionally integrated with automated dispensing system and/or automated labeling and packaging system, as claimed within the subject application, including claims 1-92, was conceived and reduced to practice at least prior to December 04, 2001, i.e., the filing date of U.S. Patent 6,715,266 to Brown.

5. Attached is exhibit A, a Functional System Description document, entitled "Auto Drug Repacking System Bottle Range" dated at least by June 02, 1999, describing the claimed invention. This document was prepared for Merck-Medco, the assignee of the present invention based on our conception of the claimed invention and under our supervision. Portions of this document not relating to the claimed invention have been redacted to minimize the disclosure of unrelated confidential information.

6. Exhibit A clearly indicates that the invention comprising an automated system for emptying contents of pharmaceutical containers including medications; an automated system for emptying the contents of pharmaceutical containers; an automated system for emptying the contents of pharmaceutical containers, including medications; and an automated

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system for emptying contents of pharmaceutical containers including medications, as claimed within the subject application, including claims 1-92, was conceived at least as early as June 02, 1999 and Exhibit B indicates that the invention was reduced to practice at least as early as June 23, 2000. Attached is Exhibit B, an email disclosing the "client witness testing of the ultrasonic bottle slitter" at least as early as June 23, 2000 wherein the present invention based on our conception of the claimed invention and under our supervision was reduced to practice as a prototype.

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- a cutter for cutting the pharmaceutical container;
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9. In addition, we conclude that we reduced to practice prior to December 04, 2001, the subject matter of claims 2-92.

10. We further declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true, and further, that these statements were made with the knowledge that the making of willfully false statements and the like is punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Signed:

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Dated:

Signed:

Christian E. Hess

Dated:

Signed:

Chih-Jen Lou

Dated:

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Mark A. Detri

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Exhibit A

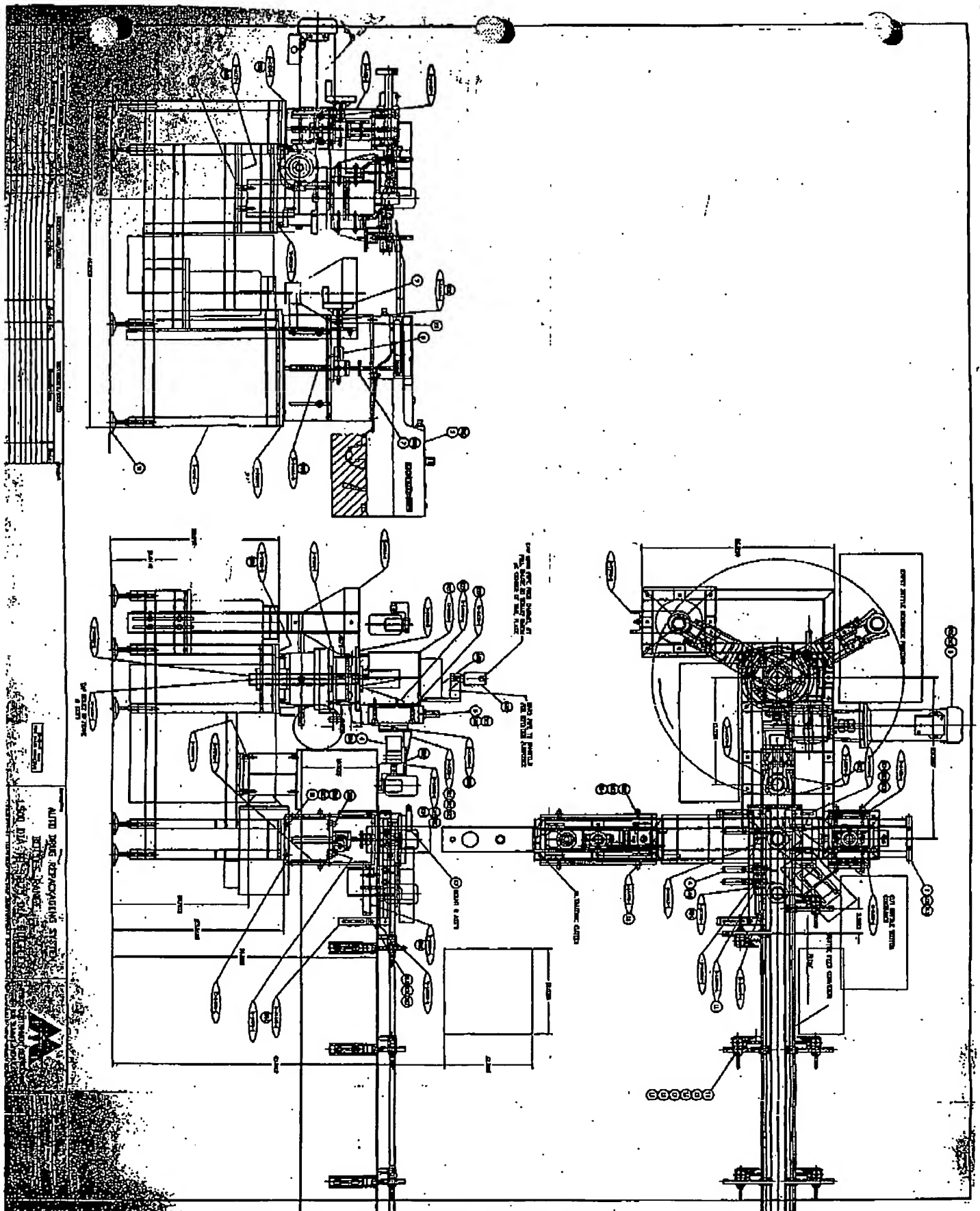


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6. Exhibit A clearly indicates that the invention comprising an automated system for emptying contents of pharmaceutical containers including medications; an automated system for emptying the contents of pharmaceutical containers; an automated system for emptying the contents of pharmaceutical containers, including medications; and an automated

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Dated:

Signed:

Christian E. Hess

Dated:

Signed:

Chih-Jen Leu

Dated:

Signed:

Mark A. Detri

Dated:

22 - Sept - 2006

Exhibit A

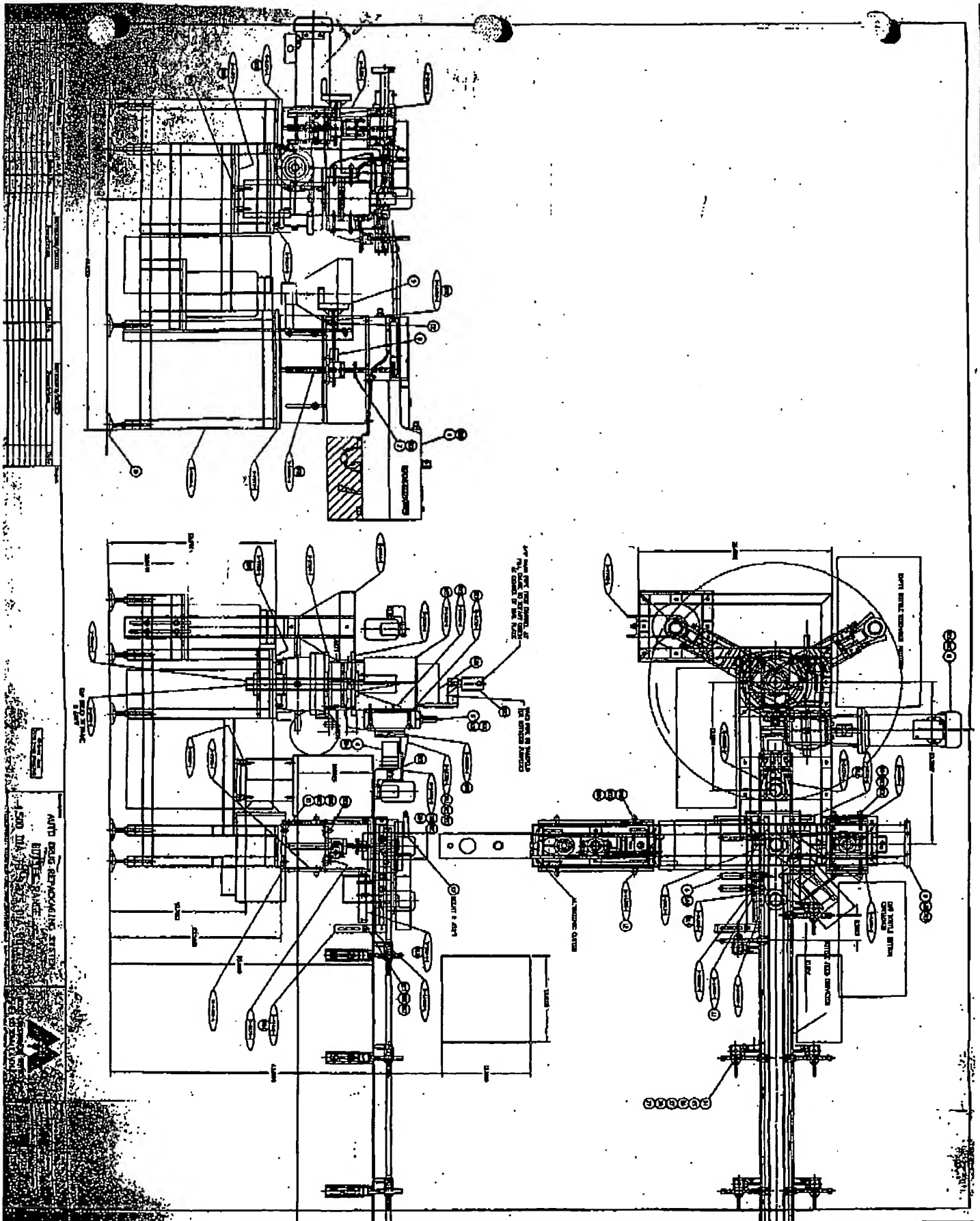


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Dated:

Signed:


Christian E. Hess

E. CHRISTIAN HESS

Dated:

22 SEP 06

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Exhibit A

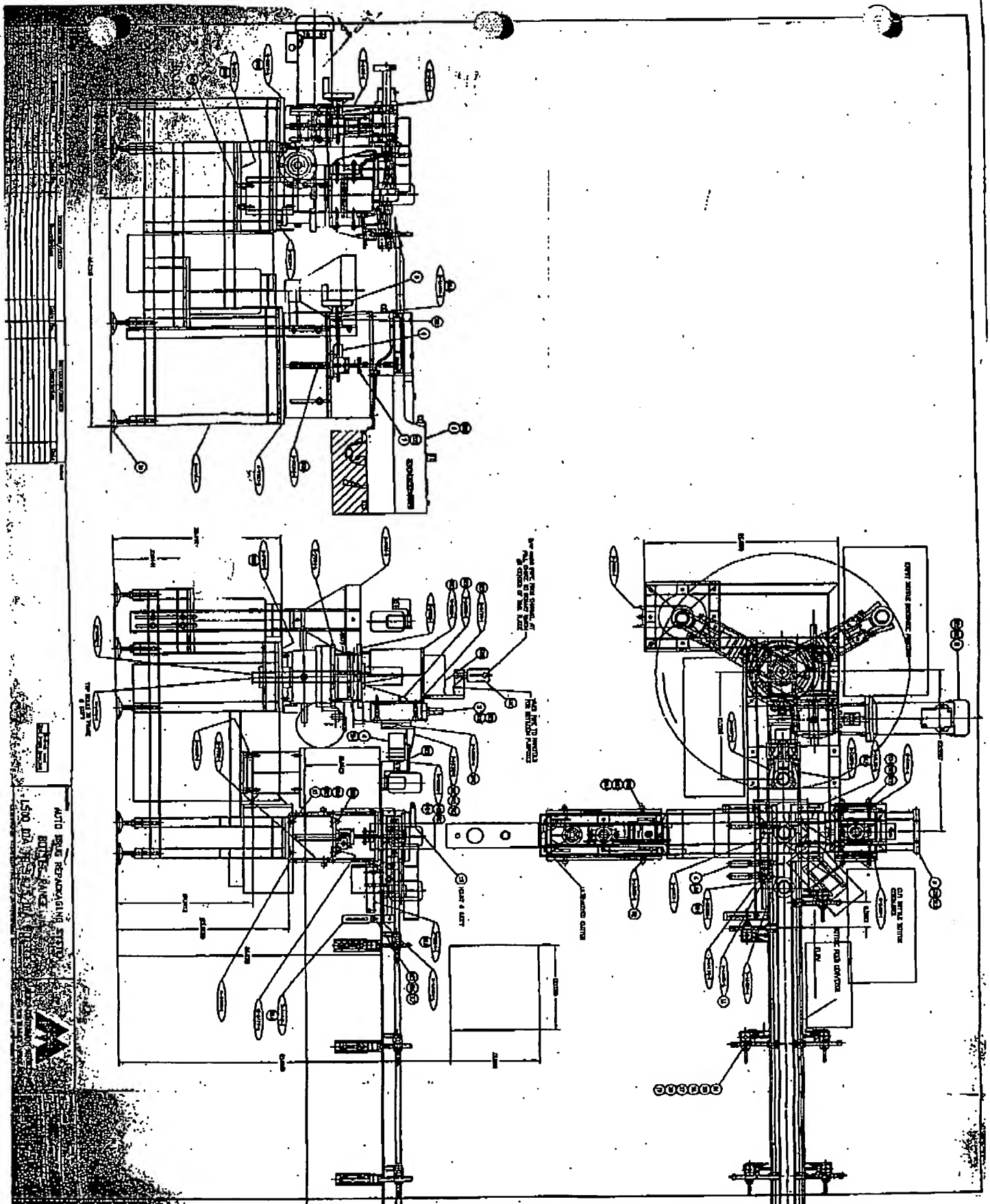


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